

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL GRAIVER and OSAMU TANAKA

Appeal No. 95-0246
Application 07/990,262¹

ON BRIEF

Before WINTERS, JOHN D. SMITH and WARREN, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 1 through 13, 21 and 23, which are all of the claims remaining in the application.

¹ Application for patent filed December 11, 1992. According to appellants, this application is a continuation of Application 07/439,751, filed November 21, 1989, now abandoned; which is a continuation of Application 07/128,250, filed December 3, 1987, now abandoned; which is a division of Application 06/809,090, filed December 12, 1985, now abandoned.

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Claim 1 is representative:

1. A method for making clear, stable, aqueous micro-emulsions of polydiorganosiloxane which comprises: sequentially adding a precursor emulsion comprised of cyclopolydiorganosiloxane, surfactant, and water to a polymerization medium comprised of water and an effective amount of a polymerization catalyst while mixing wherein the rate of addition of the precursor emulsion is effective to form a clear, stable microemulsion which has polydiorganosiloxane droplets of less than 0.15 micron average size, and which contains a surfactant to polydiorganosiloxane weight ratio of 0.15 to 5.

The references relied on by the examiner are:

Hyde et al. (Hyde)	2,891,920	June 23, 1959
Findlay et al. (Findlay)	3,294,725	Dec. 27, 1966

All of the appealed claims stand rejected under 35 U.S.C. § 103 as unpatentable over the Findlay reference, considered alone or in combination with Hyde.

DISCUSSION

Initially, we observe that the subject matter of this appeal was reviewed by another merits panel of the Board of Patent Appeals and Interferences (Board) in parent application Serial No. 07/439,751. See Paper Nos. 12 and 14 of the parent file (Appeal No. 91-3171). In the instant application, appellants have added claims 21 and 23, not previously considered by the Board. Appellants further rely on factual evidence submitted in this application but not previously before the Board. Specifically, appellants rely on the Gee affidavit, filed under the provisions of 37 CFR § 1.132, executed December 11, 1992, and

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on the Gee affidavit, filed under the provisions of 37 CFR § 1.132, executed June 21, 1993.

In light of the new record, we have taken a step back and re-evaluated the patentability of appellants' claimed subject matter over the cited prior art. On reflection, we agree with appellants that the rejections under 35 U.S.C. § 103 are not sustainable. We agree with the position and reasons succinctly stated in appellants' Appeal Brief, and we add the following comments for emphasis only.

Neither the Findlay reference alone, nor Findlay in combination with Hyde, is sufficient to support a conclusion of obviousness of claims 1 through 13, 21 and 23, requiring pre-emulsification and sequential addition "wherein the rate of addition of the precursor emulsion is effective to form a clear, stable microemulsion." Accordingly, neither Findlay alone, nor Findlay considered in combination with Hyde, establishes a prima facie case of obviousness of the appealed claims.

Even assuming arguendo that the examiner had established a prima facie case of obviousness, the objective evidence of non-obviousness relied on by appellants is sufficient to rebut any such prima facie case. Note particularly the Gee affidavit, executed June 21, 1993, showing the criticality of sequentially adding precursor emulsion to the polymerization medium. Also

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note the Gee affidavit, executed December 11, 1992, reproducing Example 14 of Findlay which the previous merits panel labeled "the closest prior art." The claimed method produces a clear, stable aqueous microemulsion, whereas Findlay's Example 14 gives rise to an emulsion which is "milky white in appearance" (Gee affidavit, executed December 11, 1992, page 3).

The examiner's decision is reversed.

REVERSED

SHERMAN D. WINTERS)	
Administrative Patent Judge)	
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)	
JOHN D. SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
CHARLES F. WARREN)	
Administrative Patent Judge)	

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